

Notice of Allowability

Application No.

09/830,810

Examiner

Anand U. Desai, Ph.D.

Applicant(s)

MATZUK ET AL.

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to June 14, 2005.
2. ☒ The allowed claim(s) is/are 2,3,5-10 and 59.
3. ☒ The drawings filed on 25 July 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. This office action is in response to Amendment filed on June 14, 2005. Claims 1, 4, 11-57 have been previously cancelled. Claims 58, 60, and 61 have been cancelled. Claims 2, 3, 5-10, and 59 are currently pending and are under examination.

Withdrawal of Rejections

2. The provisional rejection of claims 2, 3, and 59 under the judicially created doctrine of obviousness-type double patenting is withdrawn.

3. The rejection of claims 2, 3, 5-10, and 59 under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility is withdrawn.

4. The rejection of claims 2, 3, 5-10, and 59 under 35 U.S.C. 112, first paragraph because the claims is not supported by either a specific and substantial asserted utility or a well established utility, and therefore one skilled in the art would not know how to use the claimed invention is withdrawn.

5. The rejection of claim 59 under 35 U.S.C. 112, second paragraph as being indefinite is withdrawn.

EXAMINER'S AMENDMENT

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

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Authorization for this examiner's amendment was given in a telephone interview with Ms. Melissa Acosta on July 18, 2005.

Examiner's amendment to the claims:

2. (Currently Amended) An isolated polynucleotide comprising ~~having~~ the polynucleotide sequence set forth in SEQ ID NO: 1.

5. (Currently Amended) An expression vector comprising ~~including~~ the polynucleotide of claim 2.

8. (Currently Amended) A purified host cell containing the vector of claim 5.

59. (Currently Amended) An isolated polynucleotide that is fully complementary to the polynucleotide sequence ~~sequences~~ of claim 2.

Allowable Subject Matter

7. Claims 2, 3, 5-10, and 59 are allowable.

8. The following is an examiner's statement of reasons for allowance: The Appeal brief filed June 14, 2005 states on page 7 that SEQ ID NO: 1 is the same polynucleotide as the Zar1 sequence disclosed in Applicants Affidavit filed July 21, 2004 as compared to a similar polynucleotide. Applicants Affidavit filed July 21, 2004 discloses SEQ ID NO: 1 to function at oocyte to embryo transition. The prior art does not disclose a mouse sequence identified as SEQ ID NO: 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

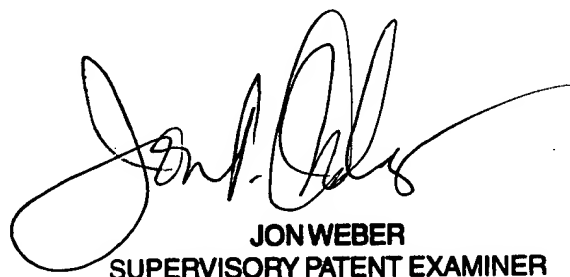
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand U. Desai, Ph.D. whose telephone number is (571) 272-0947. The examiner can normally be reached on Monday - Friday 7:00 a.m. - 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on (517) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 18, 2005



JON WEBER
SUPERVISORY PATENT EXAMINER